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By fax to 703-872-9306

Application Number: 09/884607
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First Named Inventor: Hsu
Group Art Unit: 2652
Examiner: W. Klimowicz
Atty. Docket Num. SJO919990210US1

Applicants' Response to Paper 13 dated 07-08-04

The Examiner has stated in the referenced paper that the amendment submitted by applicants' on June 4, 2004 (paper 12) is non-responsive in that the amendments made therein, in effect, change the claims to a non-elected invention. Applicants respectfully disagree.

The statutory basis for restrictions is given in 35 U.S.C. 121 as two or more distinct inventions being **claimed** in one application. The restriction requirement is, therefore, only properly based on the claims not upon the drawings. It is submitted that the Examiner has erred as a matter of law in focusing on the features in the drawings as defining scope of the restriction requirement. The elected claims are group 1 consisting of claims 1-16 and 38-42. The Examiner further required applicants to elect a species for initial examination. The applicants elected species 1 and noted that claims 1-4, 6-7, 10-15, 38 and 40-41 were to Species 1 and read on figures 3-10. Applicants also noted that claims 1, 10 and 38 are generic. The applicants assert that the scope of the elected invention is defined by the claims themselves and not by reference to the drawings which illustrate the invention. The applicants' amendments in paper 12 are consistent with the elected invention as defined in the elected claims.

Applicants' amendment added the requirement that the "third pole piece" extend to the air-bearing surface (ABS) of the head. That this is an aspect of applicants' teaching which can be included in the embodiment illustrated in

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Figures 3-10 is found in the specification on page 11, lines 13-26. The extension of the third pole piece to the ABS is clearly one of the embodiments within the scope of the invention. One of ordinary skill in the art, reading applicants specification and looking at figure 10 would realize that the extension of the third pole piece to the ABS is within the scope of the invention. Using elected claim 1 for illustration, the original claim included the following element:

"...a third pole piece of ferromagnetic material contacting the second pole piece and extending toward the back of the yoke;..."

This element does not specify whether the third pole piece extends to the ABS or not. Therefore, the original claim includes both magnetic transducers with third pole piece extending to the ABS and those that do not. Thus, the scope of the invention for restriction purposes includes magnetic transducers with third pole piece extending to the ABS and those that do not. Therefore, applicants' amendment is within the scope of the original claim 1 and the elected invention.

The fact that applicants correctly noted that the original claim 1 reads on the invention being illustrated in figures 3-10 does not, therefore, narrow claim 1 to only what is shown in these figures. As applicants noted in response to the restriction requirement, original claims 1, 10 and 38 are generic.

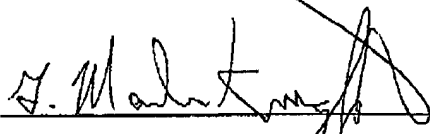
The embodiment shown in figure 11 includes a third pole piece extending to the ABS and an additional planarization surface CC. Figure 12 illustrates a completed write head 23E according to an alternative embodiment of the invention. In the write head 23E, a third coil (coil3 77), has been formed on top of coil2 57 separated by protective material 65. Both coil2 57 and coil3 77 are covered by the arching P3 53B which is shown extending to the ABS, but alternatively may be stopped short of the ABS as noted previously. (See Spec. p.12, lines 14-19). However, these differences between figures 10, 11 and 12 do not define the claimed invention either generically or as a species. It is only the claim language itself that defines the invention.

Conclusion

It is respectfully submitted that by incorrectly focusing on the drawings as defining the claimed invention, the Examiner is improperly restricting the applicants beyond what is authorized in the applicable statute. Therefore, it is

requested that the Examiner withdraw the objections to the applicants' amendment and proceed to examine the amended claims on the merits in light of the prior art.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "G. Marlin Knight", is written over a horizontal line.

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